OZE Marketing Sdn Bhd v Twenty First Century Products Sdn Bhd

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO D2-22-4183 OF 1998
ABDUL AZIZ J
27 SEPTEMBER 1999

Trade Marks *— Passing off — Misrepresentation — Descriptive name — Whether ingenious and apt description of plaintiffs' product, as well as of defendants' product — Whether trade mark has acquired secondary meaning*

The issue was whether the defendants, in using the words 'Memo Plus' for their product, have been misrepresenting that their product is the product of the plaintiffs, which is sold under the trade mark 'Memo Plus Gold'. The defendants' counsel argued that the name Memo Plus, which the defendants have been using on their product, is an ingenious and apt description of the plaintiffs' product, as well as of the defendants' product, which are memory-enhancing preparations.

Held, dismissing the application for injunction with costs:

The name Memo Plus is primarily a name that is descriptive of the product as opposed to a name that is distinctive of the plaintiffs (see p 451D–E); *McCain International Ltd v Country Fair Foods Ltd & Anor* [1981] RPC 69 followed. Therefore, by using the name Memo Plus for their product, the defendants cannot be said to represent, or misrepresent, to the public that their product is the plaintiffs' product, unless the plaintiffs show that the name has acquired a secondary meaning (see p 451E); *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 followed. However, the exhibits tendered by the plaintiffs were insufficient for the purpose of proving the acquisition of a secondary meaning (see p 452A–B).

[Bahasa Malaysia summary

Isu adalah sama ada defendan-defendan, di dalam menggunakan perkataan 'Memo Plus' untuk produk mereka, telah salah nyata bahawa produk mereka adalah produk plaintiff-plaintiff, yang djual di bawah tanda niaga 'Memo Plus Gold'. Peguam defendan berhujah bahawa nama Memo Plus, yang defendan telah gunakan dalam produk mereka, adalah cenderung untuk menggambarkan produk plaintif, begitu juga dengan produk defendan, yang merupakan penyediaan peningkatan memori.

Diputuskan, menolak permohonan injunksi dengan kos:

Nama Memo Plus pada asasnya menggambarkan produk berbanding dengan nama plaintif yang tersendiri (lihat ms 451D–E); *McCain International Ltd v Country Fair Foods Ltd & Anor* [1981] RPC 69

diikut. Oleh itu, dengan menggunakan nama Memo Plus untuk produk mereka, defendan-defendan tidak boleh dikatakan menyata atau menyalah nyata, kepada pihak awam bahawa produk mereka adalah produk plaintif, kecuali plaintiff menunjukkan bahawa nama tersebut memperolehi makna sekunder (lihat ms 451E); *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 diikut. Namun demikian, ekshibit-ekshibit yang telah dikemukakan oleh plaintif-plaintif adaah tidak mencukupi bagi tujuan membuktikan pemerolehan makna sekunder (lihat ms 452A–B).]

Notes

For cases on misrepresentation on passing off, see 12 *Mallal's Digest* (4th Ed, 1996 Reissue) paras 1229–1230.

Cases referred to

Cellular Clothing Co Ltd v Maxton & Murray [1899] AC 326 (refd)
McCain International Ltd v Country Fair Foods Ltd & Anor [1981] RPC 69 (folld)
Reckitt & Colman Products Ltd v Borden Inc [1990] 1 All ER 873 (folld)
Reddaway v Banham [1896] AC 199 (refd)

C Soosay Nathan (*S Surendran* with him) (*Christie Soosay Nathan & Associates*) for the plaintiffs.

Nad Segaram (*Shearn Delamore & Co*) for the defendants.

Cur Adv Vult

Abdul Aziz J: I think the vital question to be considered to decide whether there is a serious question to be tried is the question of misrepresentation, that is to say, whether the defendants, in using the words 'Memo Plus' for their product, have been misrepresenting that their product is the product of the plaintiffs, which is sold under the trade mark 'Memo Plus Gold'. And I think, on the question of misrepresentation, the first thing to consider is whether the name Memo Plus in the plaintiffs' trade mark Memo Plus Gold is a descriptive name. The defendants' counsel argued that the name Memo Plus, which the defendants have been using on their product, is an ingenious and apt description of the plaintiffs' product, as well as of the defendants' product, which are memory-enhancing preparations.

In *McCain International Ltd v Country Fair Foods Ltd & Anor* [1981] RPC 69, Templeman LJ, at p 73, lines 15–20, said:

> ... In my judgment, a fancy name is an indication of a single source and that is why it is impossible, generally speaking, for a defendant to appropriate the same fancy name without committing the tort of passing off.
>
> A descriptive name, on the other hand, does not indicate the source of goods, but the nature of the goods ...

In my judgment, Memo Plus is a descriptive name that may also be regarded as a fancy name. It is a fancy descriptive name.

A The word Memo is clearly intended to be an abbreviation, which to my knowledge is not recognized in the English language, for 'Memory'. The word Plus, used as a noun, means, according to the *Concise Oxford Dictionary*, an advantage, which in turn means a benefit. Since the plaintiffs' product — as is also the defendants' product — is supposed to enhance the memory, it may appropriately be called a plus, that is an advantage or B benefit, so that, were the name that is in question be Memory Plus, there could be no question but that it is a name descriptive of the product, that is to say, a preparation that is, or brings, an advantage or benefit to the memory — a memory enhancer. The difficulty arises because Memory has been abbreviated to the unrecognized form Memo. That is why I said the C name may also be regarded as a fancy name, but the fanciness is merely in the abbreviation of the word. Essentially, the abbreviation nevertheless is intended to describe the nature of the product.

At p 75, lines 27–31, of *McCain*, Templeman LJ further said:

> D ... It seems to me there may be gradations between a fancy name which means nothing, and a name which has words, or a combination of words, which are only appropriate to the goods which are put on sale. In my judgment, the distinction is between a name which is descriptive of the product and a name which is distinctive of the manufacturer.

In my judgment, the name Memo Plus is primarily a name that is descriptive of the product as opposed to a name that is distinctive of the E plaintiffs. Therefore, by using the name Memo Plus for their product, the defendants cannot be said to represent, or misrepresent, to the public that their product is the plaintiffs' product, unless the plaintiffs show that the name has acquired a secondary meaning. As Lord Oliver stated at p 885 of *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873:

> F ... even a purely descriptive term consisting of perfectly ordinary English words may, by a course of dealing over many years, become so associated with a particular trader that it acquires a secondary meaning such that it may properly be said to be descriptive of that trader's goods and his goods alone as in *Reddaway v Banham* [1896] AC 199 ... .

What secondary meaning would mean for the plaintiffs in this case is that G although Memo Plus is descriptive of a memory-enhancing preparation, it has also become descriptive of a memory-enhancing preparation associated with the plaintiffs and no one else.

It is not easy for a name descriptive of a product to acquire such a secondary meaning. To go only by the passage just quoted, it must be 'by a H course of dealing over many years'. The difficulty is such that Lord Shand even thought that a secondary meaning should not be made possible. This is what, with reference to *Reddaway v Banham* [1896] AC 199, he said in *Cellular Clothing Co Ltd v Maxton & Murray* [1899] AC 326:

> I ... it no doubt shews it is possible where a descriptive name has been used to prove that so general, I should rather say so universal, has been the use of it as to give it a secondary meaning ... But I confess I have always thought, and I still think, that it should be made almost impossible for any one to obtain the exclusive right to the use of a word or term which is in ordinary use in our

language and which is descriptive only — and, indeed, were it not for the decision in *Reddaway*'s case, I should say this should be made altogether impossible.

In their written submission in reply, the plaintiffs seek to show the acquisition of a secondary meaning of the name Memo Plus by reference to certain exhibits showing the sales performance of their product and their efforts in promoting it through publicity and advertisement — exhs SK-7 and SK-8 to encl (3). But I do not think they are sufficient for proof of the acquisition of a secondary meaning. In the first place, those exhibits were not exhibited for the purpose of proving the acquisition of a secondary meaning. Secondly, those exhibits show the use by the plaintiffs of their trade mark Memo Plus Gold. They do not show the use by the plaintiffs of the name Memo Plus by itself, which is the name that is relevant to the question of secondary meaning. Lastly, and in any event, the period shown by the exhibits is only from November 1997, which is not the 'many years' mentioned by Lord Oliver. In my judgment, the name Memo Plus has not been shown to have acquired a secondary meaning.

To conclude, there is no serious question to be tried as regards misrepresentation and therefore the plaintiffs are not entitled to the injunction sought. I dismiss the application with costs.

Application dismissed with costs.

Reported by Loo Lai Mee